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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/386,529	08/30/1999	BRIAN SHUSTER	SHUS805	1497

7590 05/31/2002

BRULL PICCIONELLI SARNO & BRAUN  
1925 CDENTURY PARK EAST  
SUITE 2350  
LOS ANGELES, CA 90067

EXAMINER

CHOUHDARY, ANITA

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 05/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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## **Office Action Summary**

**Application No.**

09/386,529

**Applicant(s)**

SHUSTER ET AL.

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**Examiner**

Anita Choudhary

## Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 08/30/1999 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) \_\_\_\_\_ is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-9 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 08/30/1999 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 88, 90, 92 of Figure 7. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the proposed name" in line 8 of claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the data" in line 18 of claim 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 is indefinite because the term "the network system," in line 2, cannot include itself (see line 3). In order to clarify the claim language, the term "network system", line 3 should have read ---- a network ----.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 8 rejected under 35 U.S.C. 102(e) as being anticipated by Stanbach Jr. et al. Stanbach shows a system for retrieving an assigned domain by a domain hosting system which identifies a computer address using second and top level name components and executes parsing (paragraph 49 lines 4-17), and identifies a second computer address (page 14 claim 3 line 1-3) and transmits the data (paragraph 14 line 8-10), as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach Jr. et al. in view of Robinson.

In considering claims 1 and 5, Stanbach Jr. et al discloses a system, substantially as claimed, for assigning domain names on a wide area network to a client by a provider computer having:

- Means for determining whether the proposed name is to be assigned to client.  
(paragraph 54 line 1-4)

Although Stanbach shows substantial features of the claimed invention, it fails to show a means for the client choosing and submitting a third level domain name extension and a provider second and top-level domain name.

Nonetheless having the client choosing a third level extension and choosing from a provider supplied second and top level extension is well known art, as evidenced by Robinson.

Robinson, in an analogous art, shows a system for assigning domain names on a wide area network, teaching means for allowing the client to choose and submit a third level extension and choose from provider supplied second and top level extension. (see line 21). Further, Robinson shows the domain name comprising clientname.providername.com (see line 21 "yourname.hostname.com"), as claimed.

Thus given the teaching of Robinson, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Stanbach, by including the client and provider extension, so that the domain name selected is customized.

In considering claim 2, see Stanbach's

- Means for verifying the availability of the proposed domain name.  
(paragraph 55 lines 5-10)

In considering claim 3, see Stanbach's

- Means for provider component comprised of a plurality of name levels greater than two. (paragraph 7 line 8-10)

In considering claim 4, see Stanbach's

- Mean for client component comprised of a plurality of name levels greater than two. (paragraph 7 line 8-10)

In considering claim 6, see Stanbach's

- Means for selecting a forth-level component. (paragraph 7 line 8-10)

In considering claim 7, see Stanbach's

- Means for storing domain name in register. (paragraph 55 line 10-25)

In considering claim 9, Stanbach further discloses the system comprising:

- Means for load balancing (scheduler) (see paragraph 18 line 4)
- Means for resolvers (redirectors) (see paragraph 10 line 7-9)
- Means for servers (see paragraph 10 line 4-7).
- Means for data storage (see paragraph 140 line 4-8).

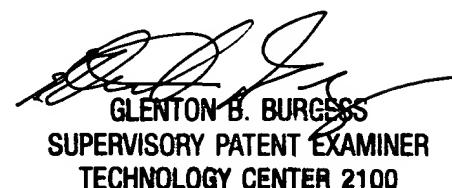
### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- PR Newswire discloses a domain name registration service through Register.com.
- Leighton et al. shows a means for a global hosting system where at least one first level name server provides a first level domain name service resolution and a second level domain name resolution.
- Overly discusses a way for negotiating a web site agreement where by the client can choose from various domain naming options.
- Walker discloses options for web hosting for business owners who wish to set up a web storefront.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita Choudhary whose telephone number is (703) 305-5268. The examiner can normally be reached on 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 305-7201. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.



GLENTON B. BURGESS  
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